

greater than 50 weight percent of a polymer component having a viscosity of less than about 50 cps. The Group III claims are directed to a method for using an extended release pharmaceutical composition comprising at least one antibiotic and greater than 50 weight percent of a polymer component having a viscosity of less than about 50 cps.

Hence all three sets of claims require that a search for an extended release pharmaceutical composition comprising at least one antibiotic and greater than 50 weight percent of a polymer component having a viscosity of less than about 50 cps be made.

An examination of the Group II or Group III claims will require a search of substantially the same prior art as an examination of the Group I claims. Each would require searching all of the art relating to extended release antibiotic compositions. Furthermore, separate examination of the Group I, II, and III claims may lead to inconsistent examinations and likely will result in duplication of effort. It is therefore a more efficient use of Patent Office manpower and resources to examine all claims which are closely related at one time rather than conducting separate examinations.

The mere fact that one set of claims is directed to a method and the other set is directed to an apparatus does not mean a patent cannot be issued containing both sets of claims. Patents are routinely issued containing method and apparatus or method and product claims.

Moreover, restriction is not "required" by 35 U.S.C. §121 as suggested by the Examiner. Congress wisely gave the Commissioner the "discretion" to require restriction. According to 35 U.S.C. § 121 "... the Commissioner may require the application to be restricted..." (emphasis added). Likewise, the MPEP § 803 lists two criteria that must be present for restriction to be proper:

- 1) The invention must be independent or distinct; and
- 2) There must be a serious burden on the Examiner if restriction is not required (emphasis added).

In addition to the restriction between Groups I, II, and III, it is noted that the Office Action also refers to an election of species at page 3 third full paragraph; however, the Office Action does not specify the species from which the Applicants have been asked to choose. If the Examiner

Application No. 10/743,367
June 10, 2010

wishes to issue a further election of species requirement – beyond that already imposed in the Office Action, of June 25, 2009 – it respectfully requested that the Examiner clarify the nature of this election in the next Office Action.

Because the Examiner has not shown any serious burden if examination of all the claims is conducted and the claims cover closely related subject matter, Applicant respectfully requests the Examiner reconsider and withdraw the restriction requirement and examine all of Claims 1 – 20.

In the event this response is not timely filed, Applicants hereby petition for the appropriate extension of time and request that the fee for the extension along with any other fees which may be due with respect to this paper be charged to our Deposit Account No. 12-2355.

Respectfully submitted,

LUEDEKA, NEELY & GRAHAM, P.C.

By: /J. David Gonce/

J. David Gonce
Registration No. 47,601

Date: June 10, 2010
P.O. Box 1871
Knoxville, Tennessee 37901
(865) 546-4305

E-Filing